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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/775,039	02/09/2004	Kevin P. Parker	PRKR-4600	6907

7590

07/06/2006

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EXAMINER

MACKEY, PATRICK HEWEY

ART UNIT	PAPER NUMBER
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3651

DATE MAILED: 07/06/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/775,039

Applicant(s)

PARKER ET AL.

Examiner

Patrick H. Mackey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-25, 46 and 48-55 is/are allowed.
- 6) ☒ Claim(s) 26-35, 37-45 and 47 is/are rejected.
- 7) ☒ Claim(s) 36 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>41006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The amendment filed 4/17/06 has been entered.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 26-35, 37-45, and 47 are rejected under 35 U.S.C. 102(b) as being anticipated by Fogg. Fogg discloses a device for conditioning an edge of a stack of sheets to be bound that includes a stack clamping mechanism (2); an array (see Fig. VII) of piercing members/(re cl. 37, mechanism) (4) with at least one ceramic cutting element (see col. 5, lines 70-75), having a plurality of individual spaced apart piercing elements/(re cl. 37, members) (5); a positioning mechanism (6); and a drive mechanism (14, 15) with a support member (11) mounted at a first location (12) that reciprocates between a withdrawn position and a piercing position (see col. 4, lines 45-61).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 27, 29, and 45 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Fogg. Fogg discloses a stack of sheets (See Fig. V). See MPEP § 2113.

6. Claims 27, 29, and 45 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ackley. Ackley discloses a stack of sheets (See Fig. 7). See MPEP § 2113.

Allowable Subject Matter

7. Claims 1-25, 46, and 48-55 are allowed.

8. Claim 36 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

9. Applicant's arguments regarding claims 26-35, 37-45, and 47 filed 4/10/2006 have been fully considered but they are not persuasive.

10. Regarding claim 26, the applicant states that Fogg does not disclose that the first or second direction falls within ± 25 degrees of a plane of the sheets, Fogg does not disclose that the second direction is generally opposite to the first direction, and Fogg does not disclose that the piercing member engages the stack at a first location and withdraws the member from the first location. The examiner disagrees with the applicant. Fogg discloses that piercing member 4 moves up to a first location and then down from the first location. The up and down movement is parallel to the claimed sheet plane.

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11. Regarding claim 30, the applicant states that Fogg does not disclose that the drive mechanism is configured to drive the piercing member into the edge of the stack at first stack location and to withdraw the piercing member from the edge of the stack at the first stack location and repeating this action at a second stack location different from the first stack location.

The examiner disagrees with the applicant. Piercing member 4 reciprocates into the stack at different stack locations (see col. 7, lines 45-65).

12. Regarding claim 37, the applicant states that Fogg does not disclose that each of the piercing edges are aligned along a single piercing axis common to all of the piercing members. The examiner disagrees with the applicant. Fogg discloses that the tips of piercing members 5 are all aligned along a single piercing axis common to all of the piercing members (see at least Fig. XXIII). The applicant also states that Fogg does not disclose that a first piercing member engages the stack at a different time than a second piercing member. The examiner disagrees with the applicant. A first piercing member 5 on a first side of piercing mechanism 4 illustrated in Fig. XXI will not engage the stack at the same time as a second piercing member 5 on an opposite side of piercing mechanism 4. Although piercing members 5 reciprocate at the same time, they engage the stack at different times.

13. Regarding claim 43, the applicant states that Fogg does not disclose that the piercing members are driven through the edge plane. The examiner disagrees with the applicant. Fogg discloses that the piercing members 4 are moved in a reciprocating direction which drives them through the edge plane. Although Fogg discloses that the piercing elements 5 enter through the side of the stack, the piercing members 4 move into the edge of the stack.

Conclusion

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14. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick H. Mackey whose telephone number is (571) 272-6916. The examiner can normally be reached on Tuesday-Friday 7:00 a.m. - 5:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

A handwritten signature in black ink, appearing to read 'PM', is positioned above the printed name of the examiner.

Patrick H. Mackey
Primary Examiner
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June 23, 2006